REMARKS

The last Office Action of September 27, 2007 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1, 3, 4, and 6–14 are pending in the application. No claims have been amended or canceled. Claims 1, 3, 4, and 6-14 remain in the application. No amendment to the specification has been made. No fee is due.

Claims 1, 3, 4, and 6–9 and 11–14 stand rejected under 35 U.S.C. §102(b) as being anticipated by US patent 6,078,847 to Eidson et al. (hereinafter "Eidson").

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Eidson in view of US patent 6,885,641 B1 to Chan et al. (hereinafter "Chan").

TRAVERSAL OF THE FINALITY OF THE REJECTION

Applicant noted in the response filed after the previous non-final Office Action mailed on May 1, 2007, that no prior art had been applied against claim 2. To expedite prosecution, applicant then amended claim 1 by incorporating the subject matter of claim 2 and canceled claim 2. Other previous amendments to the claims were made **solely** to address the rejections under 35 U.S.C. §101 and 112, and to change the dependency of several claims that depended from canceled claim 2. Applicant therefore strongly disagrees with the Examiner's statement in Section 10 of the Office Action that "Applicant's amendment necessitated the new ground(s) for rejection.

Because the Examiner was silent in the first Office Action about claim 2 (and several other claims, as noted in Applicant's previous response) and because the Examiner never presented prior art disclosing or teaching any of the features or elements recited in claim 2, Applicant was in no position and was also

not required to present any arguments regarding its patentability. Since claim 1, on file, only recites features previously recited in claim 2 and not anything else, the finality of this rejection is improper and Applicant requests that it be withdrawn.

REJECTIONS UNDER 35 U.S.C. §102(b)

Claim 1, the sole independent claim, recites a project design method for automating a control sequence in a configurable system with a plurality of components, wherein the components can exchange at regular time intervals during the control sequence information with another component via communication relationships. Exactly one system project design from a plurality of system project designs is selected with the system, based on a topology and a functionality of the components communicated to the system by a user input. The selected system project design contains exactly one component project design for each component of the system. The method further includes designing each of the components in the system according to the corresponding component project design; and causing each of the components to implement the communication relationships to the other components according to the component project design of the particular component. (Emphasis added).

As mentioned *supra*, the limitation "communicated to the system by a user input" previously recited in now canceled claim 2 was neither addressed nor rejected in the prior Office Action. The examiner now asserts that this limitation is disclosed by Eidson (col. 8, lines 27–31). The quoted section in Eidson states: "For example, a _monitoring computer system_ that can access the global communication path may implement specialized software that constructs a topological map the materials handling system 200 in response these packets broadcasted on the global communication path. Periodic broadcasting of this information enables a _monitoring computer_ system to obtain updated system topology and to determine whether any of the components have failed by failing

to broadcast the information." (Emphasis added). Eidson uses a monitoring computer system with special software, which is entirely different from having a <u>user</u> communicate topology and functionality of the components to the system, as recited in claim 1.

Because Eidson does not teach or suggest each and every feature of previously presented claim 1, claim 1 is patentable over Eidson and withdrawal of this rejection is respectfully requested.

Claims 3, 4, and 6–9 and 11–14 which depend from claim 1 are then also patentable for at least the reason that claim 1 is patentable.

REJECTION UNDER 35 U.S.C. §103(a)

Chan is applied in addition to Eidson against claim 10 which was also not addressed and rejected in the previous Office Action. Chan discloses (col. 1, lines 63–67, cited in the Office Action): "Existing management and planning tools and methodologies for such systems suffer from at least one of the following current shortcomings: ….. 6. require user knowledge and input of the configuration, customization, and capacity of the various computer and network components (e.g., processors, adapters, buses, internal and external storage, input/output microprocessors, channels, and local and wide area links), …"

Applicant is unable to find a relationship between the subject matter disclosed by Chan in this section of the '641 patent and the feature that "the plurality of system project designs is stored external to the system" recited in claim 10. Claim 10 is therefore patentable.

Withdrawal of the rejection under 35 U.S.C. §103(a) is therefore respectfully requested for the reasons stated above.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate conditions for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Respectfully submitted,

By: _____
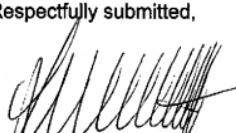
Henry M. Feiereisen
Agent for Applicant
Reg. No. 31,084

Date: December 12, 2007
350 Fifth Avenue
Suite 4714
New York, N.Y. 10118
(212) 244-5500
HMF/WS:af